

**REMARKS:**

Based on the above amendments and the following remarks, this application is deemed to be in condition for allowance and action to that end is respectfully requested.

**Summary of Amendments**

The Applicants have canceled claims 4 and 5 and amended claim 1 to more particularly define the present invention. As amended, claims 1 and 6 remain pending in the present application. No new matter has been added.

**Claim Rejection Under 35 U.S.C. § 112**

The Examiner rejected claim 1 under 35 U.S.C. § 112, first paragraph, because the second step of the claimed method "coating said printed security sheet in another step over its whole surface" is not enabled by the specification, which only describes "lacquering the whole sheet". The Applicants have amended claim 1 to substitute the term "coating" in the second step of the method with the term "lacquering". Accordingly, the claim rejection has been overcome and withdrawal thereof is respectfully requested.

**Claim Rejections Under 35 U.S.C. § 103**

The Examiner rejected claims 1, 4-6 under 35 U.S.C. § 103(a) as being unpatentable over US 3,533,176 to Weitzberg et al. (Weitzberg) in view of US 5,199,744 to Shenton (Shenton). The Applicants have amended the term "security feature" in claim 1 to "watermark" to more particularly define the present invention and canceled claims 4 and 5.

The present invention as defined in amended claim 1, relates to a method for finishing a printed security sheet carrying at least one watermark, comprising: (1) partially coating the printed security sheet in one step with a layer of lacquer to the at least one watermark such that the at least one watermark is emphasized by increasing the transparency thereof; and (2) lacquering the printed security sheet in another step over its whole surface to increase the durability of the security sheet. The Applicants have found that coating a watermark with a layer of lacquer increases the transparency of the watermark and therefore, the watermark is more clearly visible, due to the different transparencies of the watermark and its surrounding area,

which results from the different construction of the paper. Thus, the watermark can be recognized clearly even without holding the sheet against a source of light.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art references (or references when combined) must teach or suggest all the claimed limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on an applicant's disclosure in the specification. See *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q. 2d 1438 (Fed. Cir. 1991).

The Applicants respectfully submit that the combination of Weitzberg in view of Shenton (whether or not they can be combined), fails to teach or suggest, either expressly or inherently, all the limitations of the claims.

Weitzberg teaches a tamper-proof identification document comprising a base card, to one side of which there is inseparably attached a photographic layer comprising both a picture section and a data text section. The photographic layer must be secured against forgery by a transparent security coating or protective layer which inseparably adheres to the photographic layer (See column 3, lines 9-16). Weitzberg additionally teaches to provide on the photographic layer side of the document at least one additional print of characteristic pattern covered by the transparent layer, in colors different from that of the text of particulars, preferably by using combinations of different colors (See column 3, lines 37-56).

Regarding Weitzberg, the Examiner specifically contends that "the transparent/clear lacquer would also inherently emphasize/optically accentuate underlying text and photographic underlying text and photographic features". The Applicants respectfully disagree with the Examiner and submit that the inherency of an advantage and its obviousness are entirely different questions. That which may be inherent is not necessary known. Weitzberg does not teach or suggest that coating a watermark with a layer of lacquer emphasizes the watermark by increasing the transparency thereof. Obviousness cannot be predicated on what is unknown. See *In re Spormann*, 363 F. 2d 444, 150 USPQ 449 (C.C.P.A. 1966)

The Applicants further respectfully submit that the Applicants' invention solves a different problem from those addressed by Weitzberg and Shenton, and such different problem is recited in the claims of the present application.

Weitzberg addresses the problem of tamper-proofing an identification card, which is a totally different problem from the problem of increasing the visibility of a watermark addressed in the present invention. Weitzberg further fails to teach or suggest a two-step method as required in the present claims 1 and 6, much less the distinct features of the two steps, which are, first, partially coating the watermark with a layer of lacquer to emphasize the watermark by increasing the transparency thereof, and second, lacquering the whole surface of the security sheet to increase the durability of the security sheet.

Shenton teaches a method of providing a security device on a substrate comprising embossing at least one transitory image, and a linear area which is visible when the device is examined from substantially all viewing angles. Shenton further teaches that the substrate printed with metallic inks could be overprinted with a tinting lacquer to provide colored metallic effects.

Shenton addresses a problem that is totally different from that addressed in the present invention. Shenton teaches overcoating the feature that is printed with metallic inks with a lacquer to provide colored metallic effects, which is totally different from coating a watermark with a lacquer to increase the transparency and visibility thereof, as claimed in the present application. Furthermore, Shenton fails to teach or suggest a second coating of a lacquer over the entire surface of the security sheet, which is a requirement of the claimed invention.

As previously stated, the Applicants' invention solves the problem of emphasizing a watermark, which is a different problem from those addressed by Weitzberg and Shenton, and such different problem is recited in the claims of the present application. See *In re Wright*, 6 USPQ 2d 1959 (1988). Weitzberg addresses the problem of tamper-proofing a document, while Shenton addresses the problem of increasing the colored metallic effects of features printed with metallic ink. A person having ordinary skill in the art to which the claimed invention pertains, who works on increasing the visibility of watermarks on security sheets, would not look at either Weitzberg or Shenton which addresses different problems, let alone combine the references.

Weitzberg and Shenton, even if combined, still fail to teach or suggest all the limitations of the present invention as defined in claims 1 and 6, which is partially coating the printed

security sheet in one step with a layer of lacquer to the at least one watermark such that the at least one watermark is emphasized by increasing the transparency thereof. Furthermore, the combination of Weitzberg with Shenton fails to teach or suggest the two-step method of the claimed invention, which comprises partially coating the watermark with a lacquer to emphasize the watermark, and then lacquering the whole sheet. The combination of Weitzberg and Shenton do not teach or suggest: (1) partially coating the printed security sheet in one step with a layer of lacquer to the at least one watermark such that the at least one watermark is emphasized by increasing the transparency thereof; and (2) lacquering the printed security sheet in another step over its whole surface to increase the durability of the security sheet. Therefore, the claimed invention is not obvious over Weitzberg in view of Shenton. The claim rejections under 35 U.S.C. § 103(a) are overcome and withdrawal thereof is respectfully requested.

### CONCLUSION

Based on the foregoing amendments and remarks, favorable consideration and allowance of all of the claims now present in the application are respectfully requested.

Should the Examiner require or consider it advisable that the claims and/or drawings be amended in formal respects in order to place the case in condition for allowance, then it is respectfully requested that such amendment be carried out by Examiner's Amendment and the case passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, the Examiner is invited to telephone the undersigned.

The Commissioner is authorized to charge any required fees, including any extension and/or excess claim fees, any additional fees, or credit any overpayment, to Goodwin Procter LLP Deposit Account No. 06-0923.

Respectfully submitted for Applicants,



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